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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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08/819,669

03/17/1997

THIERRY BOON

LUD-5253.5-D

1995

24972 7590 03/05/2010  
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EXAMINER

GAMBEL, PHILLIP

ART UNIT

PAPER NUMBER

1644

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<p align="center"><b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b></p>	<b>Application No.</b> 08/819,669	<b>Applicant(s)</b> BOON ET AL.	
	<b>Examiner</b> Phillip Gambel	<b>Art Unit</b> 1644	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 01 October 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 08 January 2010. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: 192-195.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: 183-191.
- Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_
13. ☐ Other: \_\_\_\_\_.

/Phillip Gambel/  
Primary Examiner, Art Unit 1644

Continuation of 11. does NOT place the application in condition for allowance because: of the reasons of record.

In response to applicant's Response to Advisory Action, filed 10/01/2009 and the duplicate Response to Advisory Action, filed 10/02/2009, as well as the Status Inquiries, filed 12/02/2009 and 02/10/2010; the following is noted.

Claims 183-191 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 5,843,448 (see 892, mailed 03/28/2001) for the reasons of record.

The Terminal Disclaimer over U.S. Patent No. 5,843,448, filed 10/01/2009, has been DISapproved for the following reasons.

In contrast to applicant assertions that the terminal disclaimer does not include the common ownership language, which was the sole reason for its prior DISapproval, the following is noted.

As noted previously, given that the reference (U.S. Patent) and the pending application have the SAME effective filing / priority date; the reference does not fall within the scope of 35 USC 103(c)(1), since the U.S. Patent is NOT available under 102(e).

The record shows that the reference (U.S. Patent) is NOT prior art under 102(f) due to reversal of the examiner's rejection in this grounds in the Decision by the BPAL, mailed 01/16/2009.

In order for the entry of the terminal disclaimer, filed 10/01/2009; applicant must:

- (1) show that the reference is a 35 USC 102(g) reference and that a rejection under 35 USC 103(a)/102(g) could be made in the absence of joint research agreement and
- (2) satisfy the requirements of 37 CFR 1.71(g) by amending the specification in accordance with 37 CFR 1.71(g)(1) and the pay the fee in accordance with 1.71(g)(2) if it applies.

Further as to the terminal disclaimer, filed 10/01/2009,

- (a) the waiver provision of the terminal disclaimer omits the word "patent" when it states "separately enforce any granted on ... " and
- (b) the terminal disclaimer includes irrelevant language regarding reexamination proceedings.

The 132 Declaration is NOT the statement required by 37 CR 1.104(c)(4)(iii) because it fails to refer to a "joint research agreement, within the meaning of 35 U.S.C. 103(c)(3)..."

Rather, the 132 Declaration refers to a "joint research collaboration" (whatever that means).

35 USC 103(c)(3) states that a "joint research agreement" means "a written contract, grant, or cooperative agreement..."

There must be more than collaboration.

The terminal disclaimer, filed on 10/01/2009 and resent on 10/02/2009, disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 5,843,448 has been reviewed and has NOT been accepted for the reasons of record and set forth herein.

With respect to applicant's confusion concerning the common ownership ODP with U.S. Patent No. 7,495,074 where it is has been noted that applicant still has NOT addressed the following issue concerning double patenting with commonly assigned U.S. Patent No. 7,495,074 , the following is noted.

Applicant should address the following.

Claims 183-191 and newly added 192-195 are directed to an invention not patentably distinct from claims 1-8 of commonly assigned U.S. Patent No. 7,495,074 for the reasons of record.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned U.S. Patent No., discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

As pointed out previously, given the prosecution record of the instant application where USPTO records are INconsistent with applicant's assertions about ownership or where there was an INconsistency between applicant's statement in the Terminal Disclaimer filed 07/13/2009 about common ownership and applicant's previous Petition to Withdraw the Terminal Disclaimer, filed 12/12/2006;

applicant should clearly indicate the ownership of the instant application and that of U.S. Patent No. 7,495,074.

While applicant asserts that there is common ownership, it remains unclear whether the instant application and the patent are totally commonly owned, rather than having an owner in common.

With respect to applicant's comments about the ODP rejection itself, the claims of U.S. Patent No. 7,495,074 drawn to MAGE-4 tumor rejection antigens anticipated the instant claims.

With respect to the allowability (if rewritten into independent format) of claims 192-195,

these claims 192-195 are drawn to MAGE-2, MAGE-3, MAGE-4, wherein applicant has filed appropriate terminal disclaimers.

Although, the outstanding clarification of the common ownership between the instant application and U.S. Patent No. 7,95,074 remains.

Claims 183-191 are drawn to MAGE-1 or generically to MAGE, wherein applicant's efforts to disclaim the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 5,843,448 has been reviewed and has NOT been accepted for the reasons of record and set forth herein.

With respect to applicant's remarks in the Status Inquiry, filed 02/10/2010, that telephone messages have not been returned, the examiner notes that NO telephone messages were received personally NOR left on the examiner's voicemail by applicant.